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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,559	07/25/2003	Haruko Toyoshima	0445-0339P	9344
2292	7590	08/25/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HILL, LAURA C	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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101626559

EXAMINER

ART UNIT	PAPER
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20050809

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary

Application No.

10/626,559

Applicant(s)

TOYOSHIMA ET AL.

Examiner

Laura C. Hill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/27/03 & 4/26/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Language Interpretation

1. The term 'fastening tapes' as recited in lines 11 and 13 of claim 1 are interpreted to be any flexible strip or band with or without a male and a female member that performs an attaching/fastening function, including hook-and-loop, snaps, etc.
2. The 'extensible side part' as recited in lines 13-14 of claim 1 could be located inwardly of and/or an integral part of the tape area, and therefore the extensible part do not necessarily constitute a separate element from the fastening tape.
3. The 'below-waist portion' as recited in line 14 of claim 1 is interpreted to be any of the circumferential area located near and/or adjacent to the outermost most portion of the longitudinal ends of the article.
4. The 'basal parts' of the fastening tapes as recited in claim 3 do not necessarily have to be spaced inwardly from the fastening tapes and could be located at any position/area adjacent or near the respective fastening tape.
5. The language as recited in claim 4 is interpreted to mean that each half of the diaper divided by the centerline is substantially equal to the other half in size and/or area.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. It is unclear what is meant by the phrase 'the distance from a longitudinal end of the absorbent member to a longitudinal end of the diaper in one of the longitudinal end sections thereof, and that in the other longitudinal end section is substantially equal' (i.e.: the length of one half is equal to the length of the other half, the distance of the diaper is substantially equal to the distance of the longitudinal end section, etc?).

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Alemany et al. (US 5,234,423).

Regarding claim 1 Alemany et al. discloses a disposable diaper 20 comprising an absorbent core member 28 positioned between a liquid pervious top sheet 24 and a liquid impervious back sheet 26 (col. 6, ll. 38-42) [Note the containment assembly 22 forms the 'main body' of the diaper-i.e. the top sheet 24, back sheet 26 and core 28],

Said diaper 20 having a pair of longitudinal side and end sections each having a side edge, a crotch section located in the area between the longitudinal end sections (col. 6, ll. 63-col. 7, line 2, figure 1), and fastening tapes 42 provided on each side edge of the longitudinal end section (col. 6, ll. 48-51, col. 27, ll. 50-59, figure 1),

Wherein,

The longitudinal end section having fastening tapes 42 has a waist elastic member 34 to form an elastomeric member/extensible waist part 76 (col. 6, line 45, figure 1),

The longitudinal end section having fasten fastening tapes 42 with side panel members/extensible side part 90 formed in an area at and below the waist portion (col. 46, ll. 58-68, figure 1),

The longitudinal end of the absorbent member 28 having fastening tapes 42 is nearer to the waist portion of that section than a centerline 66 that divides the side parts of diaper 20 into equal halves (col. 7, ll. 12-15, figure 1),

A width of the absorbent member 28 located between the side parts is greater than the absorbent member width at the crotch section, forming a narrowing hourglass absorbent member (col. 9, ll. 10-16, figure 1).

Aleman et al. further discloses there is less absorbency in the front waist region due to the dual layer core (col. 14, ll. 20-27). Aleman et al. does not expressly disclose a saturation capacity ratio or natural length values.

When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02.

Regarding claim 2 Aleman et al. discloses side panel members/extensible side part 90 may comprise strands of elastomeric materials disposed in the side parts and in waistband 35 and located between the two basal parts of tape fastener 92 (col. 47, ll. 38-46, figure 1).

Regarding claims 3 and 7 Aleman et al. discloses tape tab fastener 92 joined to back sheet 26 and a further comprises a release portion 95 joined to top sheet 24 of diaper 20 (col. 29, ll. 25-26, ll.36-42, figure 1). Aleman et al. further discloses the plurality of elastic members in the side part disposed between the basal parts of the fastener tapes as discussed above with respect to claim 2.

Regarding claim 4 Aleman et al. discloses the two halves of diaper 20 formed by centerline 66 that are substantially equal in size to one another (figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alemany et al. (US 5,234,423) as applied to claim 1 above, and further in view of Breitkopf (US 5,034,008). Regarding claim 5 Alemany et al. discloses the waist elastomeric member 76 and side panel members/extensible side part 90 as discussed above with respect to claims 1 and 2. Alemany et al. further discloses the side panel members/extensible side part 90 may comprise polyurethane foams to conform to the waist of the wearer as the wearer sits, stands or moves (col. 47, ll. 53-66, col. 51, ll. 62-67). Alemany et al. does not expressly disclose the waist elastic member comprise urethane foam. Breitkopf discloses disposable diaper 10 with waist elastic element 28 made of polyurethane foam for enhanced comfort and containment (col. 1, ll. 57-61, col. 5, ll. 66-68, col. 6, ll. 8-18, figure 1). It is well known to those of ordinary skill in the art

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that polyurethane contributes to contraction and expansibility for use with nether garments as taught by McGuire (US 3,312,981). One would be motivated to modify the waist elastic member of Alemany et al. with polyurethane foam of Breitzkopf since both references disclose disposable diapers with waist elastic elements that contract for improved fit. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the waist elastic member of Alemany et al., thus providing a waist elastic member comprising urethane foam.

Regarding claim 6 Alemany et al. discloses the diaper 20 having absorbent member 28 as discussed above with respect to claim 1. Alemany et al. does not expressly disclose the flexural stiffness values of the absorbent member. Flexural stiffness is a result-effective variable since it is dependent on the materials used in the absorbent member, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alemany et al. with flexural stiffness values, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch and Slaney*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Toyoshima (US 2002/0151863 A1) is cited for showing a disposable diaper 1 with waist elastic members 7,8 having a plurality of urethane film elastic pieces and fixed between the top sheet and back sheet for putting the diaper on regardless of user position. Reising et al. (US 4,581,580) is cited for showing diaper 10

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with extensible side flap 22, a polyurethane foam elastic waistband 18 fixed between top sheet 12 and hourglass-shaped absorbent core 14. Sauer (US 6,264,639)) is cited for showing diaper 10 with elasticized side margins 34 and end margins 38, 40, hourglass-shaped absorbent core and tape fasteners 50.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Hill whose telephone number is 571-272-7137. The examiner can normally be reached on Monday through Friday (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laura C. Hill
Examiner
Art Unit 3761



TATYANA ZALUKAEVA
PRIMARY EXAMINER

